

REMARKS

Claims 79-96 and 98-110 were presented for examination and were rejected. Independent claims 79 and 95 have been amended to further clarify that they require the multiple force chip to be a 'single chip'. This is supported throughout the specification and particularly at page 37, thus the amendment adds no new matter. Entry of the amendment and reconsideration in view of the following comments is respectfully requested.

Double Patenting Rejections

Certain of the claims were provisionally rejected based on alleged obviousness-type double patenting in view of co-pending application serial no. 09/679,024. These rejections rely upon a combination of the claims of the 09/679,024 application with certain references, particularly Pourahmadi et al.

The applicant understands that these rejections can be eliminated by a suitable Terminal Disclaimer, and requests that the requirement for filing such a Terminal Disclaimer be held in abeyance until such time as allowable subject matter is identified in the applications.

Rejection Based on 35 USC § 102(e)

Claims 79, 80, 82-85, and 87-94 were rejected as allegedly anticipated by Pourahmadi, et al., US 6,440,725. According to the Examiner, "Pourahmadi et al. disclose a biochip system wherein at least one of the chips (see col. 2, lines 27-33, disclosing incorporation of microfluidic chips or components into larger cartridges having any desired combination of microscale to macroscale channels, chambers, etc.; the cartridge, being comprised of more than 1 chip, is deemed to be a chip itself because it has all the structures of a chip and can be of a small scale, and a chip can be formed from separate components so long as the components are integrated into a unit) is a multiple force chip..."

The applicant traverses this rejection for at least the following reasons. An anticipation rejection is only proper if a single prior art reference discloses all limitations of the claim exactly as they appear in the claim. Pourahmadi does not do that.

First, the Examiner pieced together disjointed disclosures from Pourahmadi to create this rejection rather than relying upon any device that Pourahmadi discloses. The “resistive heating element 34” as described in the passage cited by the Examiner is depicted in Figure 7; neither Figure 7 nor the associated description indicates that the structure depicted in Figure 7 contains any other features of the claims. It does not anticipate the invention as claimed. Similarly, the discussion at col. 19, lines 17-19 and continuing through line 65 relates to means for temperature control of parts of the cartridge. IT describes numerous options for controlling temperature, including means that could be internal or external to a cartridge, but it does not describe a chip having a heating element that also contains the other features of the claimed invention. Similarly, the discussion cited by the Examiner in col. 3, lines 50-55 says that a cartridge may ‘contain or be coupled to’ a heating element: it does not disclose any chip having a heating element in combination with the other features of the claims. These isolated disclosures in the reference do not describe any device that combines the features required by claim 79. Thus Pourahmadi cannot support an anticipation rejection of claim 79 or any claim dependent therefrom, because it does not disclose any device that contains all limitations of claim 79, it just describes some separate features that could in principle be combined into a cartridge.

Moreover, the Examiner’s own statement of the rejection demonstrates why the Pourahmadi cartridge is not a “chip”: the Examiner explicitly described the Pourahmadi device as “being comprised of more than 1 chip”. This demonstrates that the Examiner understands a chip to be unambiguously different from a ‘cartridge’, and the Examiner understands the Pourahmadi device to be a cartridge rather than a chip. Nevertheless, the Examiner “deemed” the cartridge to be a chip for purposes of the rejection, taking a position that is inconsistent with the Examiner’s own usage of the word ‘chip’. This rejection is based on a meaning of ‘chip’ that contradicts the ordinary usage of the word ‘chip’ as used in the cited reference; and it contradicts the Examiner’s own usage of the word ‘chip.’ Thus treating the cartridge of Pourahmadi as a ‘chip’ is inconsistent

with the express description in the reference, which says the cartridge can contain a chip, and with the ordinary usage of the word, and with the Examiner's Own usage of the word chip, which is improper.

The claims have been amended to explicitly indicate that they require at least one 'single chip' in the claimed system to be a multiple force chip. In view of the comments above and this amendment, the anticipation rejection is overcome and should be withdrawn.

Rejection Based on 35 USC § 103

As discussed above, the rejections based on Pourahmadi rely upon considering the 'cartridge' of Pourahmadi to be a 'chip', when both the reference *and* the Examiner's own description of the cartridge demonstrate that it is Not a chip, merely a device that could contain one or more chips. Thus the rejections based on Pourahmadi are improper; they do not show that Pourahmadi discloses or suggests a single chip that is a multiple force chip meeting the limitations of the independent claims 79 and 95. The cartridge of Pourahmadi is not a chip, just as a laptop computer is not a 'chip': each can contain one or more chips, and they may have chip(s) that are integrated with other elements into a device, but it is unreasonable to consider either the laptop *or* the cartridge to be a 'chip'. The Examiner's theory of obviousness improperly combines various features that Pourahmadi contemplates having in a cartridge; it does not rely on what Pourahmadi says about a chip. Pourahmadi fails to disclose or suggest a chip having the features of claim 79 or of claim 95, which is the other independent claim at issue. Supporting reference Blankenstein, cited in rejection of claims 95 et seq., does not overcome the deficiencies of Pourahmadi. Therefore, the obviousness rejections based on Pourahmadi are overcome and should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 471842001500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: August 9, 2007

Respectfully submitted,

By: /Michael G. Smith/

Michael G. Smith

Registration No.: 44,422

MORRISON & FOERSTER LLP

12531 High Bluff Drive, Suite 100

San Diego, California 92130-2040

(858) 720-5113